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EXAMINER

NOLAND, THOMAS

ART UNIT

PAPER NUMBER

2856

DATE MAILED: 08/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09544225

Applicant(s)

Hia H et al

Examiner

Tom M. L. J

Group Art Unit

2056

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 5/28/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 111; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-22 is/are pending in the application.
- Of the above claim(s) 21-22 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-19 is/are rejected.
- ☒ Claim(s) 20 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. Applicant's election with traverse of the invention of group 1, claims 1-20 in Paper No. 11, filed May 28, 2003 is acknowledged. The traversal is on the ground(s) that the inventions are not both independent and distinct and there would be no serious burden in searching and examining all 3 groups, especially since 2 of the groups are classified in the same subclass. This is not found persuasive because of the reasons advanced in the original requirement. It is well settled that the language of 35 U.S.C. 120 is to be interpreted as allowing restriction if the inventions are independent or distinct. Thus no showing of independence is required. Applicant's arguments regarding lack of burden due to common classification between group 1 and group 2 are noted but since clearly the claims in the different groups do not require searching for all the same features searching for both groups would clearly be a burden when the other criteria for restriction have been met as herein. Applicant's argument that group 1 inherently defines the use of an ejection position does not appear to have merit since clearly no precise ejection position is defined therewithin nor is such required. The requirement is still deemed proper and is therefore made FINAL.

2. Claims 21-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 11.

3. Applicant is requested to cancel claims 21-22 in any response hereto.

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4. Claims 1-20 are objected to because of the following informalities: In claim 1, line 4 "said material" should be --the material--. In line 8 "the" should be --a--. In claim 4, line 1 "said hardened" should be --the hardened--. In claim 6, line 2 "A" should be --a--. In line 3 "the opposite end" should be --an opposite end thereof--. In claim 7, line 1 "a" should be --an--. In claim 8, line 2 "said opening" should be --the opening--. In claim 9, line 6 "the" should be --an--. In line 9 "said open" should be --the open--. In line 11 "a" should be --the--. In claim 15, line 1 "said" should be --the--. In claim 16, line 8 "periphery" should be --peripheral--. In line 9 "a" should be --the--. In claim 17, line 2 "said ejector" should be --the ejector--. In claim 20, line 2 "the samples" should be --samples--. Appropriate correction is required.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 5-9, 11-12 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Pfaff, Jr. US 5,365,815.

Note especially the abstract and Figs. 1-2. The removed strips would inherently be considerable as samples.

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7. Claims 1, 5-9 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Thurston US 17,408.

Note especially Figs. 1 and 3 and page 1, line 85- page 2, line 10. The cut soles could be considered to be sample strips.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thurston US 17,408 in view of Pfaff, Jr. US 5,365,815.

Thurston does not show the placement of cutters 90 degrees apart but such is shown as a useful configuration in Pfaff, Jr. and thus would have been an obvious expedient to provide greater stripping coverage or ease collection.

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over (Pfaff, Jr. or Thurston) in view of Okamoto et al, US 4,833,930 cited by applicant.

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Pfaff, Jr. and Thurston do not specifically teach that the cutter is hardened but such would have been an obvious expedient in view of the cutting function to make the cutler more durable and in view of the teaching by Okamoto et al in col. 3, lines 64-66 of using a hardened element in a sample cutter.

11. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Pfaff, Jr. or Thurston) in view of Okamoto et al as applied to claim 2 above, and further in view of Mathews et al US 5,309,768 cited in specification.

12. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pfaff, Jr. in view of Mathews et al.

Pfaff, Jr. and Thurston show apparatus substantially as claimed in claims 3-4 but do not disclose the use of a non adhesive coating as set forth. However such would have been an obvious expedient to ease sample removal and help prevent contamination especially in view of the teaching of the similar use of such a coating in the similar sampler/strip handler of Mathews et al. Likewise Pfaff, Jr. shows apparatus substantially as claimed in claim 19 but does not disclose the use of the strip as a conveyor to means to test and remove the strip but such is shown by Matthews et al to be a known use of conveyors in sample strip handlers and thus would have been an obvious means of monitoring to use.

13. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over (Pfaff, Jr. or Thurston) in view of Maxey et al US 3,547,170.

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Pfaff, Jr. and Thurston do not teach making the die removable and of various sizes but such would have been an obvious expedient to allow greater versatility in sampling and/or cutting and in view of the use of a replaceable cutter in the similar rotary cutter of Maxey et al. Note especially Fig. 7 of Maxey et al which shows a replaceable cutter with enough space to increase the size if desired. Note also col. 3, lines 3-15 therein.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references show sampling and/or rotating cutters.

15. Claim 20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Noland whose telephone number is (703) 305-4765. The examiner can normally be reached on weekdays from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Hezron E. Williams, can be reached on (703) 305-4705.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

8/18/03
Thomas P. Noland
Primary Examiner
Art Unit 2856



Noland/ek
08/14/03